PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Art Unit   2623

Levy et al.   Confirmation No.   7267

Application No.:   10/804,581

Filed: March 18, 2004

For: SYNCHRONIZING BROADCAST
        CONTENT WITH CORRESPONDING   **Via Electronic Filing**
        NETWORK CONTENT

Examiner: R. Stronczer

Date: March 3, 2009

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellants request review of the final rejection in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets. (No more than 5 pages are provided.)

	Respectfully submitted,
Date: March 3, 2009	DIGIMARC CORPORATION

Customer Number 23735

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REASONS FOR REQUEST FOR PRE-APPEAL REVIEW

Sir:

Responsive to the final Office Action dated October 3, 2008, Applicant files herewith a notice of appeal, a request for pre-appeal brief review, and the following reasons for requesting the pre-appeal review.

In the final Office Action, the drawings are objected to as allegedly not showing features of claim 23, claim 26 is rejected as being indefinite for lack of antecedent basis of consumer devices, and pending claims 1-29 are rejected under 35 U.S.C. Section 103(a) as being unpatentable as follows:

- Claims 1, 2, 5-8, 11-16, 18, 20-24, and 26-29 are rejected over a combination of U.S. Patent No. 6,018,768 to Ullman et al. ("Ullman") and U.S. Patent Publication 2004/0139474 of Carro ("Carro");

- Claims 3, 4, 9, 10, 19 and 25 are rejected over Ullman, Carro and Levy; and

- Claim 17 is rejected over Ullman, Carro and Linnartz.

As shown in Fig. 2 of Ullman, Ullman teaches a server URL decoder 24 that extracts URL codes from a video broadcast and sends them to an Internet server, which in turn, sends the URL codes to the user's PC. Carro teaches a similar function as Ullman, but instead of extracting the URL codes from the broadcast, it uses the channel and viewing time to look up URLs. Applicant acknowledges that both Ullman and Carro identify network content through

URL codes. However, neither Ullman nor Carro teach posting of the identified network content as claimed. The Office expressly acknowledges this defect of Ullman in its rejection, but Applicants respectfully submit that it incorrectly relies on Carro as teaching the elements that are admitted to be missing from Ullman.

After closer study of Carro, it is clear that Carro does not teach or suggest the elements of claim 1 that are missing from Ullman. Carro's system operates as follows:

1: A user views a broadcast program and finds topics of interest. See paragraph [0172] and Fig. 1.

2. The user selects the topics on his "user device" (308 in Fig. 3) by selecting the channel and viewing time. See paragraphs [0173-0180] and Figs. 2 and 3.

3. The user device records the channel and time of viewing corresponding to the topics of interest in a Universal Time Table 401 (Fig. 4 shows an example of this Universal Time Table, with three entries: channel, selection time, and URL of the channel information server for the channel). See paragraphs [0181-0182].

4. The user device sends the selection of the channel and time as stored in the Universal Time Table (505) to the channel information server (502) to retrieve the names and URLs of corresponding hyperlinks for that channel and time. See paragraphs [0185-0188] and Fig. 5.

5. The channel server (602) returns to the user's computer, the updated table that correlates the channel and time with the corresponding name and URLs. See paragraphs [0189-0190] and Figs. 6 and 7.

Carro does not teach posting the corresponding network content on a network device located at the network address as claimed in the novel combination of claim 1. The channel information server stores a table that provides URLs corresponding to times for a particular broadcast channel. In effect, the times and channels indirectly identify the URL codes, but Carro's system needs the channel information server to identify the URL code by using the time and channel to look up pre-stored URLs at the channel information server. Carro teaches an indirect way of looking up URLs relating to broadcast content by using time and channel information. Carro uses the term "synchronization" in the context of this use of broadcast time to look up corresponding URLs that are stored at the channel information server for given time intervals. While this association of URLs and times is updated in a database of the channel

information server during transmission of a broadcast as indicated in paragraph [0108] of Carro, there is noting in either reference that suggests that this impacts the posting of corresponding network content on a network device at these URL addresses. The URL codes themselves are not "corresponding network content on a network device located at the network address." Moreover, simply updating the URL codes for time intervals in the database on the channel information server does not provide one of skill in the art relevant teachings on the missing elements from Ullman because the updating of the channel information server is not performed "after the corresponding network content thereby as been identified" as claimed. Instead, Carro updates the channel information server in a manner that is independent of any identifiers in the broadcast content.

Relative to Ullman, Carro only adds that the user device can look up the URLs through a database in the channel information server by providing the channel information server with the viewing time. The channel information server in Carro simply stores a table that matches time intervals with URLs. The network content that is identified by these URLs is not posted to the network device at the network address after that network content is identified as claimed. There is no posting of "the corresponding network content" to the channel information server or the web servers at the identified URLs after the network content has been identified. Likewise, in Ullman, there are no postings to the Internet server as claimed. Thus, one of skill in the art could not find the necessary teachings to assemble all of the elements of a method for synchronizing broadcast content with dynamic network content posted at a network address after the network content is identified as claimed because neither one teaches posting network content in the manner claimed.

Regarding claim 5, the elements of claim 5 are not inherent in Fig. 2 of Ullman. As explained at col. 5, line 62, to col. 6, line 2 of Ullman, the URL decoder 24 strips out the URL codes and sends them to Internet server 28, which delivers the URL code to the user PC 16. The posting of network content to the network device at the address represented by those URL codes is not discussed, and therefore, there is no teaching how or when that posting occurs. Since there are multiple methods in which that posting might occur, the claimed method of posting cannot be inherent in Ullman.

Regarding claim 6, the Office's position of inherency is based on the incorrect assertion that the updated universal time table 701 in Carro represents network content that is updated in response to decoding a URL code in Ullman. There at least two errors in the Office's assertion of inherency. First, the Office is mixing two different references while attempting to assert that the claim element is inherent in one reference. Second, the updated universal time table 701 is updated on the user device, not the channel information server, by retrieving pre-stored information from the channel information server and entering it in the table on the user device so that the table is updated on the user device (not the server). See paragraph [0196] of Carro. There is no updating or posting of network content occurring on the channel information server in this teaching of Carro, but instead, pre-stored URLs are merely being retrieved by the user device to update the table on the user device.

The rejection of claim 8 relies on the same incorrect assumptions as claim 6.

The rejection of claim 11 is based on inherency within an incorrect combination of Ullman and Carro, and therefore has similar problems as the rejection of claim 6. As stated in paragraphs [0189] and [0196] and shown in Fig. 6 of Carro, the user device sends the viewing time to the channel information server and gets back URLs (603), which are then updated in the universal time-table in the user device. The Office's assertion that users go to the channel information server to see a dynamically updated list of URLs embedded in the video program is not correct. Instead, the user device retrieves the URLs that are pre-stored on the channel information server in a manner that is not related to anything embedded in the video program. Moreover, there is no teaching that the HTML content located at these URLs is dynamically updated. Carro's teaching of updating the database on the channel information server with URLs for time intervals does not teach or suggest that the HTML content at the locations represented by these URLs is dynamically updated.

Regarding claim 24, the contention that the web site control is inherent in "extracting the URL from the video broadcast and updating universal time table 701 of Carro" is erroneous because Carro does not extract URLs form the video broadcast. The Office cannot base an inherency argument based on the disparate teachings of different references. Moreover, as explained above, the updating of the universal time table 701 is performed on the user device in Carro and does not involve posting web content at said URL when corresponding content is

broadcast. Therefore, the Office has cited Carro as teaching posting of web content, which it does not teach in the manner claimed.

The rejections of the over claims over combinations of Carro and Ullman are respectfully traversed for similar reasons.

Regarding the objection to the drawings, Fig. 1 and the other Figures, along with the specification, adequately teach one of skill in the art how to make and use the invention of claim 23 and as such, the elements of claim 23 are adequately shown to provide an understanding of the invention according to 37 C.F.R. 1.81. Fig. 1, for example, shows a system in which the method of claim 23 can be implemented. In particular, the specification teaches that the ID extractor 42, along with the staging system and server 50, 52 in Fig. 2, can be used to implement an embodiment of the method of claim 23 by warning the web site operator as described at page 10, lines 8, 13.

Regarding the rejection of claim 26 under 35 U.S.C. 112 as being indefinite, the term "consumer devices" is properly introduced in this claim and then referenced later as "the consumer devices."

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